



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/815,957	04/02/2004	Naoyuki Kawanishi	Q80132	8928

23373 7590 04/19/2006

SUGHRUE MION, PLLC
2100 PENNSYLVANIA AVENUE, N.W.
SUITE 800
WASHINGTON, DC 20037

EXAMINER

CHEA, THORL

ART UNIT	PAPER NUMBER
----------	--------------

1752

DATE MAILED: 04/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/815,957

Applicant(s)

KAWANISHI ET AL.

Examiner

Thorl Chea

Art Unit

1752

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 February 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 23-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 23-42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 09/893,750.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on February 8, 2006 has been entered.
2. The rejections in paragraphs 1-4, 8-10 set forth in the Final Office action is withdrawn in view of the amendment and the applicants' argument on February 8, 2006.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

- (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
- (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 1752

5. Claims 23-42 rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Yasuda (US Patent No. 6,783,925).

See process disclosed in Examples in columns 58-82, especially the process for forming a silver salt of a fatty acid and in Example 1, Table 61 in columns 61-62, and the process for providing the an image forming layer on a support in column 66, lines 50-69; the process using ultra-filtration and in column 10, and high pressure dispersion apparatus in the abstract, and column 6, lines 35-48. The processing step(a) presented in claims 23, 27, 36 is considered as an intermediate processing step for forming silver salt of an organic acid for used in the process of producing a thermally processed image recording material, and fails to differentiate the process the claimed process from that disclosed in the applied prior art of record. In the absence of providing a convincing evidence showing that difference between the silver salt of an organic acid or thermally processed image recording material and that disclosed in the applied prior art of record, the Examiner asserts that the invention as claimed is either anticipated by or would have been found prima facie obvious to the worker of ordinary skill in the art at the time the invention was made.

Response to Arguments

6. Applicant's arguments with respect to Yasuda (US Patent No. 6,783,925) filed June 15, 2005 have been fully considered but they are not persuasive for the reason set forth in the rejection above.

With respect to Yasuda the applicants argue that Yasuda is silent as to the step of "supplying the solution containing silver ions into the reaction field before being introduced into the sealed mixing means", and the method disclosed by Yasuda does not satisfy "removing by-product salt

Art Unit: 1752

containing in the reaction mixture through ultrafiltration membrane during or after the dispersion operation. Yasuda merely carried out ultrafiltration prior to the dispersing operation. The applicants also argue that Tables 1-3 of the present specification at pages 88, 107 and 111 fully demonstrate that the material produced by the claimed method exhibit superior effects. One skilled in the art would not have readily predicted such superior effects before the claimed invention was made.

The argument is not persuasive. Yasuda et al is directed to the use of closing mixing mean and the adding of silver ion-containing solution and the solution of fatty acid alkali metal may be any one of such that adding both liquid in the same closed mixing apparatus; or such that adding either one of which in the upper stream side of the closed mixing apparatus. See column 8, lines 50-68. Therefore, the mixing of adding of silver ion-containing solution and the solution of fatty acid alkali metal is not critical so long as the both of the reactant are mixed in the sealed mixing mean. The step of supplying the solution containing silver ions into the reaction field before being introduced into the sealed mixing means is therefore disclosed by Yasuda. The step of removing by-product salt containing in the reaction mixture through ultrafiltration membrane during or after the dispersion operation is also disclosed in Yasuda et al in column 60, lines 5-15 which discloses the dispersion of the silver behenate in water and then the solid content was separate by "suction filtration". This suction filtration is equivalent to the ultrafiltration process and disclosed in Yasuda et al in column 9, line 67. Therefore, the limitation as claimed is taught in Yasuda et al. The argument with respect to the superior effects is not persuasive. First, the rejection is related to the rejection under 35 USC 102(e) and "(E)vidence of secondary considerations, such as unexpected results or commercial success, is irrelevant to 35 U.S.C 102

Art Unit: 1752


rejections and thus cannot overcome a rejection so based. In re Wiggins, 488 F.2d 538, 543, 179 USPQ 421, 425 (CCPA 1973). Second, the superior effect is not sufficient to rebut the prima facie of obviousness rejection. The results should be found unexpected by the worker of ordinary skill in the art. Third, the results are not commensurate with the scope of the claimed invention. The results in the specification is related to the silver behenate while the scope of the claimed is related to any type of organic silver salt. Accordingly, it is believed that the rejection is still proper and should be maintained.


Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thorl Chea whose telephone number is (571) 272-1328. The examiner can normally be reached on 9 AM-5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia H. Kelly can be reached on (571)272-1526. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Tchea 
2006-04-17


Thorl Chea
Primary Examiner
Art Unit 1752